

The opinion in support of the decision being entered today is *not* binding  
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BERNARD A. TRAVERSAT, LI GONG, KULDIPSINGH  
PABLA, WILLIAM J. YEAGER, MOHAMED M. ABDELAZIZ,  
MICHAEL J. DUIGOU, ERIC POUYOUL, JEAN-CHRISTOPHE  
HUGLY, WILLIAM N. JOY, and MICHAEL J. CLARY

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Appeal 2007-2225  
Application 10/054,809  
Technology Center 2100

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Decided: August 31, 2007

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Before KENNETH W. HAIRSTON, LANCE LEONARD BARRY, and  
HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-111, the only claims pending in this  
application. We have jurisdiction under 35 U.S.C. §§ 6(b), 134(a).

## INTRODUCTION

The claims are directed to a system and method for providing advertisements in a peer-to-peer networking environment. Claims 1 and 110 are illustrative:

1. A peer-to-peer network system, comprising:

a plurality of peers, wherein each peer comprises a network node configured to communicate with one or more other ones of said peers over one or more networks;

a peer advertisement for each of said peers, wherein each peer advertisement comprises an identification of and communication address for a corresponding one of said peers;

a plurality of peer services or content provided by one or more of said peers; and

a service or content advertisement for each of said services or content, wherein each service or content advertisement comprises an identification of a corresponding service or content and an indication of how to access the corresponding service or content.

110. A computer-readable storage medium configured to store program instructions, wherein the program instructions are computer-executable to implement:

a peer node broadcasting a discovery query message specifying a type of resource on the network; and

the peer node receiving one or more advertisements for the specified type of resource in response to said discovery query message;

wherein each advertisement is a programming language independent metadata document formatted in accordance with a peer-to-peer protocol.

The Examiner relies on the following prior art references to show unpatentability:

|          |                    |                                       |
|----------|--------------------|---------------------------------------|
| Borella  | US 6,269,099       | Jul. 31, 2001                         |
| Teodosiu | US 2002/0062375 A1 | May 23, 2002<br>(filed Sep. 13, 2001) |

“Microsoft Computer Dictionary”, Microsoft, 4<sup>th</sup> Edition, 1999, 252.

The rejections as presented by the Examiner appear to be as follows:

1. Claims 110 and 111 are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.
2. Claims 110 and 111 were rejected in the Final Rejection under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Answer does not expressly withdraw the rejection, but neither does it repeat it. *See Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957) (rejection not referred to in the examiner’s answer is assumed to have been withdrawn). We conclude that the § 112, first paragraph rejection has been withdrawn.
3. Claims 1-4, 8-16, 18-34, 36-52, 54-61, 63-72, 74-81, 83-100, and 102-111 are rejected under 35 U.S.C. § 103(a) as unpatentable over Teodosiu and Borella.
4. The Final Rejection rejected claim 17 under 35 U.S.C § 103(a) as unpatentable over Teodosiu, Borella, and Microsoft Dictionary. The Answer adds claims 35 and 73 to the rejection, without notification that a new ground of rejection has been entered.
5. The rejection of claims 5-7, 53, 62, 82, and 101 is expressly withdrawn in the Answer (3).

## OPINION

### *Section 101 rejection*

Claims 110 and 111 recited a “tangible, computer accessible medium” configured to store program instructions. The claims were rejected (Final Rejection 2) because, in the Examiner’s view, they were not limited to tangible embodiments. The rejection made reference to page 127 of the Specification, referring to tangible embodiments (storage media) and intangible embodiments (transmission media or signals). The Examiner directed that the rejection could be overcome by amending to include only physical computer media and not transmission media or other intangible media. The Examiner further indicated that transmission media would not be statutory but storage media would be. (*Id.*)

Appellants submitted an amendment after final rejection, proposing to amend claims 110 and 111 to their present form. The Examiner indicated that the amendment would be entered for purposes of appeal (Advisory Action mailed Sept. 13, 2006), and that an explanation of how the amended claims would be rejected was “provided below or appended.” (*Id.*) The Advisory Action, however, does not explain how the amended claims would be rejected, other than by reference to “prior art.”

The Examiner in the Answer (4) again rejects claims 110 and 111 as being directed to nonstatutory subject matter, again referring to page 127 of the Specification. According to the rejection in the Answer, the Specification provides evidence that Appellants intend “the medium” to include signals, a form of energy, which is not one of the four categories of invention. The rejection in the Answer also submits that claims 35-38, 43, 44, 46, and 61 are drawn to a form of energy and not statutory, but we

presume that a new ground of rejection has not been entered against those claims.

Appellants in the Reply Brief (2) argue that the relevant portion of page 127 of the Specification distinguishes storage media (presently claimed) as magnetic or optical media (such as disk, RAM, or ROM) from transmission media or signals such as electrical, electromagnetic, or digital signals conveyed via a communication medium.

We agree with Appellants that the referenced portion of the Specification does not support the Examiner's position that the present claims are intended to encompass a form of energy. Because the basis for the rejection of the claims is in error, we do not sustain the rejection of claims 110 and 111 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

*Rejections over the prior art*

The instant application was filed in the USPTO on January 22, 2002. The Examiner's rejections over the prior art rely on Teodosiu, a U.S. utility patent application filed on September 13, 2001 and published May 23, 2002. The application thus may be a reference under 35 U.S.C. § 102(e)(1), as the (Teodosiu) application for patent was filed in September 2001, apparently "before the invention by the applicant for patent." The date of the instant invention, if considered to be the date of filing of the application in the USPTO, is later than the Teodosiu application filing.

However, according to Appellants, the instant application claims benefit under 35 U.S.C. § 119(e) for the filing of four provisional applications, ranging in date from January 22, 2001 to July 31, 2001. All the

provisional applications thus predate the September 13, 2001 filing date of Teodosiu.

The Examiner does not find that any of the claims rejected over the prior art has an effective filing date later than the filing date of Teodosiu. Therefore, the rejections over the prior art are based, conversely, on the implicit findings that each of the claims that are rejected are fully supported by provisional applications relied upon by Appellants. Although there are no express findings, we assume that the Examiner has verified that every claim rejected over the prior art finds support in the provisional applications.

The Examiner applies Teodosiu against the claims because, according to the face of the published application, the application purports to be a “Non-provisional” of two provisional applications filed on November 22, 2000, both of which predate all of Appellants’ provisional applications.

We will assume for the purposes of this appeal that U.S. provisional applications can contribute to the effective filing date of a published application. Appellants appear not to contend otherwise, but seem to argue that the use of provisional applications is limited by *In re Wertheim*, 646 F.2d 527, 209 USPQ 554 (CCPA 1981), in much the same way that the effective filing date of U.S. patents, as references, may be limited when there is a continuation-in-part in a chain of priority under 35 U.S.C. § 120.

In light of the rejections set forth by the Examiner, however, we can further assume, for the purposes of this appeal, that provisional applications can have prior art effect to the greater extent described in the *Manual of Patent Examining Procedure* (MPEP) § 706.02(f)(1) (Eighth Ed., Rev. 5, Aug. 2006), “Example 2.” According to Example 2, a published U.S. nonprovisional application that claims “benefit” under 35 U.S.C. § 119(e) to

a prior U.S. provisional application is to be accorded the earlier filing date as its prior art date “under 35 U.S.C. § 102(e),” assuming the earlier-filed application “has proper support for the subject matter as required by 35 U.S.C. 119(e). . . .” “[T]he subject matter” must refer to whatever subject matter in a published application that is relied upon in a rejection over the prior art. “[B]enefit” under § 119 requires, *inter alia*, an invention disclosed in the provisional application “in the manner provided by the first paragraph of section 112” (35 U.S.C. § 119(e)(1)), so “proper support” must refer to at least written description support as required by 35 U.S.C. § 112, first paragraph.

Appellants allege (Appeal Br. 15-18; Reply Br. 3-6) that the Teodosiu provisional applications vary greatly from the published utility application, and that a comparison between the published application and the provisional applications shows that the teachings in the published application on which the rejection relies are largely missing from the provisional applications.

The Examiner’s statements of rejection over the prior art (Answer 5-12) refer to text in Teodosiu, and appear not to mention the provisional applications that are the basis for alleging that Teodosiu can be considered prior art. With respect to Appellants’ arguments regarding the deficiencies of the Teodosiu provisional applications, the Examiner responds that “the provisional” and the published application of Teodosiu disclose the same invention. “Even though, the Provisional application is shorter, but it provided the base for the published application. Under U.S.C.112, it does not mention that the provisional application and the utility application have to be the same length or exactly the same word by word with the utility application.” (Answer 15.)

The allocation of burdens requires that the USPTO produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). The one who bears the initial burden of presenting a prima facie case of unpatentability is the examiner. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The Examiner has not provided copies in this appeal of the two provisional applications in controversy, much less shown where any kind of § 112 support may be found in the provisional applications for the subject matter of the published application upon which the rejection relies. In accordance with the Examiner's theory that some or all of the Teodosiu published application may be applied against the instant claims, the rejection should show, to establish a prima facie case for unpatentability, where § 112 support resides in the earlier provisional applications for each instance of specific subject matter relied upon in the published application, including an explanation why the provisionals would still be recognized by the artisan as providing support if not "word for word" the same as the later text or drawings. Mere reference to the text or drawings of Teodosiu is not sufficient. The Teodosiu published application, by itself, shows no more than the material published from the application that was filed in the USPTO on September 13, 2001, which, according to this record, is later than the effective filing date of each of the claims rejected.

Thus, even if we assume that a published application may have an effective filing date as prior art based on earlier filed provisional applications, the rejections that rely on Teodosiu fail to set forth a prima



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facie case for unpatentability. Because Teodosiu is used in all the rejections under 35 U.S.C. § 103, we do not sustain any of the standing rejections over the prior art.

### CONCLUSION

In summary, the rejection of claims 110 and 111 under 35 U.S.C. § 101 as being directed to nonstatutory subject matter is reversed. The rejection of claims 1-4, 8-52, 54-61, 63-81, 83-100, and 102-111 under 35 U.S.C. § 103 is reversed.

REVERSED

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